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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,817	08/05/1999	SHARON R. GARBER	54419US1B014	5974

7590 08/22/2002
ATTENTION: PETER L OLSON
OFFICE OF INTELLECTUAL PROPERTY COUNSEL
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EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/368,817

Applicant(s)

GARBER ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 19-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 27 February 2002.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 20-23, 26-35 and 40-43, drawn to RFID device and method, comprising interrogation of information from RFID element and locating the RFID element, classified in class 235, subclass 492.
- II. Claims 7-12, drawn to method of using RFID device, comprising interrogating a barcode associated with an item and storing that information on an RFID element, classified in class 235, subclass 462.01.
- III. Claims 13-16, 19, 24, 25 and 36-39, drawn to a method of obtaining information of a group of items having RFID element associated therewith, comprising sorting the group of items, classified in class 235, subclass 375.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention I is in class/subclass 235/492 and invention II is in class/subclass 235/462.01. The invention I including the special technical feature defined in claims 1-6, 20-23, 26-35 and 40-43 with respect to the prior art is an indicator for indicating information regarding one or both of a

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class of materials to which the items belongs, and a desired location for that item, solving the objectively defined problem of locating an RFID element. The invention II including the special technical feature defined in claims 7-12 with respect to the prior art are interrogating an optical bar code associated with an item to obtain information about that item, and storing that information on RFID element to create a tag for the item, solving the objectively defined problem of how to store information into a RFID tag on an element that can be read from a bar code. Therefore, the invention I and the invention II are distinct from each other.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention I is in class/subclass 235/492 and invention III is in class/subclass 235/375. The invention I including the special technical feature defined in claims 1-6, 20-23, 26-35 and 40-43 with respect to the prior art is an indicator for indicating information regarding one or both of a class of materials to which the items belongs, and a desired location for that item, solving the objectively defined problem of locating an RFID element. The invention III including the special technical feature defined in claims 13-16, 19, 24, 25 and 36-39 with respect to the prior art is organizing the identification information in a predetermined order; and providing an output indicative of that order, solving the objectively defined problem of how to sort a group of RFID items. Therefore, the invention I and the invention III are distinct from each other.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention II is in class/subclass 235/462.01 and invention II is in class/subclass 235/375. The

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invention II including the special technical feature defined in claims 7-12 with respect to the prior art are interrogating an optical bar code associated with an item to obtain information about that item, and storing that information on RFID element to create a tag for the item, solving the objectively defined problem of how to store information into a RFID tag on an element that can be read from a bar code. The invention III including the special technical feature defined in claims 13-16, 19, 24, 25 and 36-39 with respect to the prior art is organizing the identification information in a predetermined order; and providing an output indicative of that order, solving the objectively defined problem of how to sort a group of RFID items. Therefore, the inventions II and III are distinct from each other.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-F 6:00-1:30 and Sat 6:00-11:00.

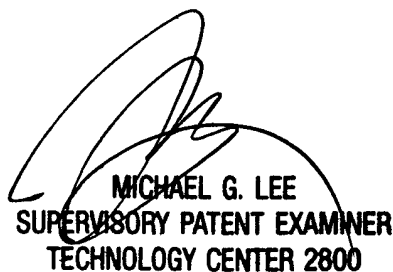
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Vyen Chau N. Le

August 14, 2002



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800